BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants:	Yves Maetz, et al.
Serial Number:	10/540,146
Atty. Docket:	PF030017
Filing Date:	June 21, 2005
For:	DEVICE AND PROCESS FOR ACQUIRING FILES BY ACCUMULATION OF POINTS
Art Unit:	2425
Examiner:	Pinkal R. Chokshi

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the final Office Action dated July 6, 2009, and further to the Notice of Appeal filed on January 6, 2010, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application within two months of the submission of the Notice of Appeal. This Appeal Brief considered to be timely filed on March 8, 2010 (as March 6, 2010 is a Saturday).

No oral hearing is requested.

I. Real Party in Interest

The real party in interest is Thomson Licensing LLC.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellants, the Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 15-27 are pending in this application, and are rejected. Claims 1-14 and 28-29 are cancelled. The rejection of claims 15-27 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of July 6, 2009 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 15 defines an acquisition device for obtaining files by accumulating points, for at least one user of at least one receiver of data of at least one communication network (see, for example, page 5, lines 4-6), said user being able to earn points by occurrences of at least one predefined operation accomplished by said user (see, for example, page 5, lines 6-8), and to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file (see, for example, page 5, lines 8-10),

wherein said device comprises an automatic control module for ordering downloading portions of said file via said network (see, for example, page 5, lines 12-13); and

a storage means (element 10 of FIGS. 1-3), accessible to said receiver, which stores portions of said file, designed to order the downloading of each of said portions when the number of points earned by said user reaches a fraction of said

predetermined level which corresponds to said each portion from said portions (see, for example, page 5, lines 13-17).

Dependent claim 17 further defines the acquisition device for obtaining files of claim 16, and states: wherein the module for prior selection allows said user to select at least two contents, and said device comprises a module for apportioning said points earned into at least two accounts associated respectively with contents (see, for example, page 9, lines 22-25).

Dependent claim 18 further defines the acquisition device for obtaining files of claim 17, and states: wherein it comprises a module for allocating priority designed to permit said user to choose an order of priority of assignment of the points earned to said accounts (see, for example, page 9, lines 28-31).

Dependent claim 19 further defines the acquisition device for obtaining files of claim 18, and states: wherein the apportioning module is designed to assign the points earned to the account benefiting from the highest priority (see, for example, page 10, lines 6-9), and when the aggregate number of points in respect of the account benefiting from the highest priority reaches said predetermined level, to assign the additional points earned to the accounts having lower priorities, according to said order of priority (see, for example, page 10, lines 10-13).

Independent claim 26 defines an acquisition process for obtaining files by accumulating points (see, for example, page 4, lines 26-28 and page 11, lines 29-32), in which a user of a receiver of data of a communication network earns points by accomplishing at least one predefined operation, and acquires at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file (see, for example, page 5, lines 4-10),

wherein a downloading via said network to a storage space accessible to said receiver, of portions of said file is ordered automatically by ordering the downloading of each of said portions when the number of points earned by said user reaches a fraction

of said predetermined level which corresponds to said portion (see, for example, page 5, lines 12-17).

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

A.   The rejection of claims 15-16 and 20-27 under 35 U.S.C. §103(a) based on the proposed combination of U.S. Patent No. 7,389,522 issued to Shintani (hereinafter, "Shintani") and U.S. Patent Publication No. 2005/0193414 by Horvitz (hereinafter, "Horvitz"); and

B.   The rejection of claims 17-19 under 35 U.S.C. §103(a) based on the proposed combination of Shintani, Horvitz and U.S. Patent Publication No. 2003/0167205 by Maruyama (hereinafter, "Maruyama").

VII. Argument

A. Patentability of Claims 15-16 and 20-27

The rejection of claims 15-16 and 20-27 under 35 U.S.C. §103(a) based on the proposed combination of Shintani and Horvitz should be reversed for at least the following reasons.

Appellants first note that independent claim 15 recites:

"Acquisition device for obtaining files by accumulating points, for at least one user of at least one receiver of data of at least one communication network, said user being able to earn points by occurrences of at least one predefined operation accomplished by said user, and to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file,
wherein said device comprises an automatic control module for ordering downloading portions of said file via said network; and
a storage means, accessible to said receiver, which stores portions of said file, designed to order the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said each portion from said portions."

As indicated above, independent claim 15 defines an acquisition device for obtaining files by accumulating points, for at least one user of at least one receiver of data of at least one communication network. The user is able to earn points by occurrences of at least one predefined operation accomplished by the user, and to acquire at least one of the files by downloading the file via the communication network when the aggregate number of points reaches a predetermined level associated with the file. The device comprises an automatic control module for ordering downloading portions of the file via the network. Storage means, accessible to the receiver, stores portions of the file and is designed to order the downloading of each of the portions when the number of points earned by the user reaches a fraction of the predetermined level which corresponds to each portion from the portions. The other independent claim at issue in this appeal, claim 26, defines subject matter similar to independent claim 15, but is drafted in "process" format versus "device" format.

Appellants respectfully submit that neither Shintani nor Horvitz, whether taken individually or in combination, discloses or suggests each and every element recited by independent claims 15 and 26 for at least the following reasons.

On page 2 of the final Office Action dated July 6, 2009, the Examiner alleges that the primary reference, Shintani, discloses the feature of "acquisition device for obtaining files by accumulating points, for at least one user of at least one receiver of data of at least one communication network" recited by independent claim 15, and specifically alleges that this feature is disclosed by the Abstract and FIG. 2 of Shintani where a device displays commercials and viewers earn points for watching those commercials.

Appellants respectfully disagree with the foregoing allegations for at least the following reasons. Neither the Abstract nor FIG. 2 of Shintani discloses an "acquisition device for obtaining files", as recited by independent claim 15. Rather, the Abstract and FIG. 2 of Shintani merely describe a viewer responding to a response request and adding points to his smart card. The user may then view a pay program using the points recorded in his smartcard. Accordingly, Shintani fails to disclose or suggest, *inter alia*, an "acquisition device for obtaining files", as recited by independent claim 15.

On page 3 of the final Office Action dated July 6, 2009, the Examiner alleges that Shintani discloses the feature of "to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file", as recited by independent claim 15, and specifically alleges that this feature is disclosed by column 4, lines 33-40 of Shintani where the viewer is able to watch a pay program by using his number of points collected by viewing commercials.

Appellants respectfully disagree with the foregoing allegations for at least the following reasons. From the cited passage of Shintani, it is clear that Shintani is focused on using accumulated points for being able to view pay broadcasting, not for the acquisition of files by downloading, as recited by independent claim 15. Accordingly, Shintani does not disclose or suggest, inter alia, the feature of "to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file", as recited by independent claim 15.

Also on page 3 of the final Office Action dated July 6, 2009, the Examiner alleges that Shintani discloses the features of "wherein said device comprises an automatic control module for ordering downloading portions of said file via said network" and "when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said each portion from said portions", as recited by independent claim 15. Specifically, the Examiner alleges that these features are disclosed by column 4, lines 19-44 of Shintani, arguing that the viewer earns points by viewing commercials, and when the viewer earns enough points, he can order a pay program to watch, and his points are reduced for watching this pay program. The viewer can continue and watch another pay program using his points until he runs out of point values as represented in FIG. 2.

Appellants respectfully disagree with the foregoing allegations for at least the following reasons. From the cited passage of Shintani and FIG. 2 thereof, and as

previously indicated above by Appellants, it is clear that Shintani is focused on using accumulated points for <u>being able to view pay broadcasting</u>, not for the <u>acquisition of files by downloading</u>, as recited by independent claim 15. In addition, Shintani clearly indicates that accumulated points are used to pay for an <u>entire</u> (whole) pay broadcast program (i.e., "the toll of a pay broadcasting", see, for example, column 4, line 35). Shintani nowhere discloses or suggests that accumulated points can be used to pay for <u>portions</u> of pay broadcasting, let alone that earned points are used to <u>download portions of files</u> (as claimed).

Also on page 3 of the final Office Action dated July 6, 2009, the Examiner admits that Shintani fails to disclose the feature of "automatically downloading portions of said file via said network and a storage space accessible to said receiver, which stores portions of said file, designed to order the downloading of said portions", as recited by independent claim 15. In an attempt to remedy this admitted deficiency of Shintani, the Examiner relies on the teachings of Horvitz, and specifically alleges that "it would be obvious to one of the ordinary skills in the art at the time of the invention to modify Shintani's system by downloading and storing viewer's preferred programs in the storage system as taught by Horvitz in order to automated caching of content and give the system a go ahead for automated policies for downloading future television program" (see page 4 of the final Office Action dated July 6, 2009).

Appellants respectfully disagree with the foregoing allegations regarding the proposed modification of Shintani for at least the following reasons. First, Appellants submit that one skilled in the art would not find any motivation to combine Shintani with the cache system of Horvitz. As indicated above, Shintani is focused on earning points to have the right to view a pay broadcast. The cache system of Horvitz has several aspects, among which are: 1) automatically storing selected content in a cache, which is advantageous to allow users to find content of interest (see, for example, paragraphs [0003-0005], where the content selection is based on a user's previous viewing habits), and 2) storing portions of data selections in a cache, which is advantageous when selections have faster viewing rates than receiving rates from a source that makes the content available on demand (see paragraphs [0007 and 0014]).

Clearly, the first aspect of Horvitz is related to automatically downloading an entire or whole item of content in a cache according to a user's previous viewing habits in order to solve a problem of finding content of interest, whereas the second aspect of Horvitz is focused on storing portions of selections in a cache to solve a problem related to a data receiving rate in a content-on-demand environment.

Clearly, one skilled in the art would not have any motivation to combine the automatic storing of whole items of content in a cache, as taught by Horvitz, with the "earning points to have the right to view a pay broadcast" system of Shintani. Likewise, one skilled in the art would not have any motivation to combine the storing of portions of data in a cache, as taught by Horvitz, with the "earning points to have the right to view a pay broadcast" system of Shintani; the storing of portions of data of Horvitz is related to content available on demand, whereas Shintani is about broadcast. Moreover, even if one of ordinary skill in the art would modify Shintani's system by downloading and storing viewer's preferred programs in a cache, as taught by Horvitz, he would still not arrive at the invention as recited by independent claim 15.

Accordingly, for at least the foregoing reasons, independent claim 15 is deemed patentable over the proposed combination of Shintani and Horvitz. Claims 16, 20-25 and 27 depend from, and further define, independent claim 15, and are deemed patentable for at least the same reasons stated above in connection with independent claim 15. Additionally, as indicated above, independent claim 26 defines subject matter similar to independent claim 15, and is therefore deemed patentable for at least the same reasons as independent claim 15.

Accordingly, for at least the foregoing reasons, Appellants respectfully request that the Board reverse the rejection of claims 15-16 and 20-27.

B. Patentability of Claims 17-19

The rejection of claims 17-19 under 35 U.S.C. §103(a) based on the proposed combination of Shintani, Horvitz and Maruyama should be reversed for at least the

following reasons. Claims 17-19 depend from, and further define, patentable independent claim 15. Moreover, Maruyama is unable to remedy the deficiencies of Shintani and Horvitz pointed out above in connection with independent claim 15. Accordingly, Appellants submit that claims 17-19 are patentable over the proposed combination of Shintani, Horvitz and Maruyama, and respectfully request that the Board reverse the rejection of claims 17-19.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,

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March 8, 2010

VIII. Claims Appendix

15.   Acquisition device for obtaining files by accumulating points, for at least one user of at least one receiver of data of at least one communication network, said user being able to earn points by occurrences of at least one predefined operation accomplished by said user, and to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file,

wherein said device comprises an automatic control module for ordering downloading portions of said file via said network; and

a storage means, accessible to said receiver, which stores portions of said file, designed to order the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said each portion from said portions.

16.   Acquisition device for obtaining files according to Claim 15, wherein it comprises a module for prior selection of at least one content by said user, said downloaded file carrying said content.

17.   Acquisition device for obtaining files according to Claim 16, wherein the module for prior selection allows said user to select at least two contents, and said device comprises a module for apportioning said points earned into at least two accounts associated respectively with contents.

18.   Acquisition device for obtaining files according to Claim 17, wherein it comprises a module for allocating priority designed to permit said user to choose an order of priority of assignment of the points earned to said accounts.

19.   Acquisition device for obtaining files according to Claim 18, wherein the apportioning module is designed to assign the points earned to the account benefiting from the highest priority, and when the aggregate number of points in respect of the account benefiting from the highest priority reaches said predetermined level, to assign

the additional points earned to the accounts having lower priorities, according to said order of priority.

20. Acquisition device for obtaining files according to claim 15, wherein it comprises a module for recording the aggregate number of points in respect of the acquisition of each of said files and a module for communicating said aggregate number to said user.

21. Acquisition device for obtaining files according to claim 15, wherein the ratio of sizes of each of said portions of file with respect to said file is equal to the ratio of the number of points of said fraction associated with said portion with respect to said predetermined level for said file.

22. Acquisition device for obtaining files according to claim 15, wherein the automatic control module is designed to order said downloading on each of said occurrences.

23. Acquisition device for obtaining files according to claim 15, wherein the automatic control module is designed to order the downloading of files of at least one of the following types: MPEG video files and MP3 audio files.

24. Acquisition device for obtaining files according to claim 15, wherein it comprises a module for detecting said occurrences.

25. Acquisition device for obtaining files according to Claim 24, wherein said operations are chosen from at least one of the following operations: viewing of advertisements, listening to advertisements, consulting of Internet sites and responses to questionnaires by telecommunication.

26. Acquisition process for obtaining files by accumulating points, in which a user of a receiver of data of a communication network earns points by accomplishing at least one predefined operation, and acquires at least one of said files by downloading of

said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file,

wherein a downloading via said network to a storage space accessible to said receiver, of portions of said file is ordered automatically by ordering the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said portion.

27.   Interactive terminal wherein it comprises an acquisition device for obtaining files in accordance with Claim 15.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.